

REMARKS

Upon entry of this amendment, claims 1-19 and 40 are pending. Claims 1 and 10 have been amended and new claim 40 has been added. The Examiner is kindly requested to enter this amendment.

Claim Rejections-35 USC § 103

Claims 1, 2-4, 6, 10, 13, 14 and 16 are rejected under 35 USC § 102(b) as being anticipated¹ By Goto US Patent No. 6, 013, 332 (“the Goto patent”) in view of Goldberg US Patent Application Publication No. US 2005/0274903 A1 (“the Goldberg publication”). There are several issues regarding this rejection in addition to the issue previously pointed out. First, the Goldberg publication is NOT prior art with respect to the teaching for which it was cited., namely, the “other boranes” including octadecaborane cited in paragraph [0034] of the Goldberg publication.

The earliest effective date of a US Patent is its filing date. The Examiner’s attention is respectfully directed to 35 USC § 102 (e) . Even though the Goldberg publication is not issued, it cannot have an earlier effective date than an issued US patent. The filing date of the Goldberg publication is May 19, 2005. The present application claims priority to US provisional application no. 60/463,965, filed April 18, 2003. Thus, the Goldberg publication is not prior art.

We note that the Goldberg publication is a continuation-in-part of US patent application no. 10/394,665, filed on March 24, 2003, now US Patent No. 6,905,947 (“the ‘947 patent”). Neither the ‘947 patent nor British patent no. GB 0207398.9 upon which the ‘947 patent claims priority disclose “other boranes” including octadecaborane as cited in paragraph [0034] of the Goldberg publication. In fact, the ‘947 patent and the British patent only disclose decaborane, thus teaching away from other boranes including octadecaborane.

¹ The Applicant assumes that the rejection is based upon 35 USC §103.

In addition, the Applicant disagrees with the following statement in Paragraph 6 of the Detailed Action.

“Goto teach having a Boron molecule = 10 which would be within the applicants range of $B > 10$. “

It is respectfully submitted that the symbol $>$ is commonly known to mean “greater than”. Thus, $B > 10$ means a molecule with more than 10 boron atoms. Accordingly, the recited range of $B > 10$ does not include or read on $B = 10$. The Goto patent is limited to decaborane, i.e. $B = 10$. The Goto patent does not disclose or suggest forming boron hydride B_nH_m molecules, where n and m are integers and $n > 10$ and $m \geq 0$. For all of the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims at issue.

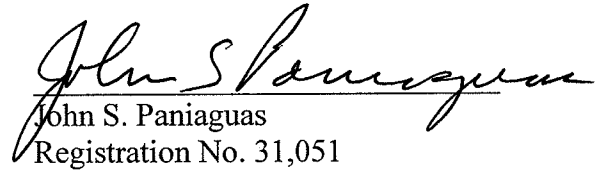
Claims 5, 7-9, 15 and 17-19 have been rejected under 35 USC § 103 (a) as being unpatentable over the Goto patent in view of Gregg et al US Patent Application Publication No. US 2005/0006799 A1 (“the Gregg et al publication”). The Goto patent was discussed above. It is respectfully submitted that the Gregg et al publication is NOT prior art with respect to the present application. In particular, the filing date of the Gregg et al publication is June 1, 2004. As mentioned above, the present application claims priority to US provisional application no. 60/463,965, filed April 18, 2003. Thus, the Gregg et al publication is not prior art. Moreover, the Gregg et al publication does not disclose or suggest forming boron hydride B_nH_m molecules, where n and m are integers and $n > 10$ and $m \geq 0$. Finally, Claims 7-9 and 17-19 are dependent upon claims 1 and 10, respectively. For all of the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims at issue.

Claims 11 and 12 have been rejected under 35 USC § 103 (a) as being unpatentable over the Goto patent in view of Horsky et al US Patent Application Publication No. US 2004/002202 A1 (“the Horsky et al publication”). Claims 11 and 12 are dependent upon Claim 10. The Goto patent was discussed above. The Horsky et al publication does not disclose or suggest forming boron hydride B_nH_m molecules, where n and m are integers and $n > 10$ and $m \geq 0$. For all of the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims at issue.

Respectfully submitted,

KATTEN MUCHIN ROSENMAN LLP

By:

A handwritten signature in black ink, appearing to read "John S. Paniaguas", written over a horizontal line.

John S. Paniaguas

Registration No. 31,051

Attorney for Applicant(s)

Katten Muchin Rosenman LLP
2900 K Street, N.W.
Suite 200
Washington, D.C. 20007-5118
(312) 902-5200
(312) 902-1061
Customer No.: 27160